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10/748,682	12/31/2003	Ross Koningstein	16113-632001 / GP-186-00-	1976
26192 7590 10/08/2008 FISH & RICHARDSON P.C. PO BOX 1022 MINNEAPOLIS, MN 55440-1022				
EXAMINER				
LE, KHANH H				
ART UNIT		PAPER NUMBER		
3688				
NOTIFICATION DATE		DELIVERY MODE		
10/08/2008		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PATDOCTC@fr.com

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

A. Claims 1-33, 34-64, 65-75, and 76-83 drawn to method and system for advertising in an electronic document including delivering to an end user a morphing advertisement which includes instructions to enable the end user system to change from a first display format to a second display format different from the first display format classified in class 715, subclass 526.

B. Claims 84-93, and 94-103 drawn to method and system for determining and delivering one or more advertisements based at least in part on the associated price parameter, the subject of the requester interest, and area-based parameters classified in class 705, subclass 14.

C. Claims 104-108, 109-113, 114-118 drawn to method and system for providing an advertiser with an interface to provide input data for a morphing advertisement, the input data including at least one URL for the first display format and at least one image for the second display format, classified in class 715, subclass 500 and/or 781.

Inventions A, B, and C are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. See MPEP § 806.05(d).

In the instant case, as compared to subcombination B, subcombination A has separate utility such as subcombination A allows a higher interaction between the user and the advertisement than in subcombination B (i.e. it has a morphing advertisement which includes

instructions to enable the end user system to change from a first display format to a second display format different from the first display format, which subcombination B does not have). Subcombination B has a separate utility in that it can be used in situations where allowing user interaction with the ad is not desired. Subcombination B also has a separate utility in that it can be used in e.g. bidding systems where determining and delivering the advertisements are based on price parameters.

As compared to subcombination A, subcombination C has at least clear separate utility such as the provided interface is for the advertiser as opposed to an implied interface for a consumer-user to which subcombination A is drawn. Thus subcombination C has separate utility in a advertiser-driven system as compared to the customer-driven system of subcombination A. Further subcombination C has the first data for the 1st display format is an URL which is not required in subcombination A, thus showing further non-overlapping of scopes and non-obviousness between the subcombinations.

As compared to subcombination B, subcombination C has separate utility such as subcombination C allows a higher interaction between the user and the advertisement than in subcombination B (i.e. it has a morphing advertisement which subcombination B does not have). Subcombination B has a separate utility in that it can be used in situations where allowing user interaction with the ad is not desired. Subcombination B also has a separate utility in that it can be used in e.g. bidding systems where determining and delivering the advertisements are based on price parameters.

The examiner has required restriction between subcombinations usable together. Where applicant elects a subcombination and claims thereto are subsequently found allowable, any claim(s) depending from or otherwise requiring all the limitations of the allowable subcombination will be examined for patentability in accordance with 37 CFR 1.104. See MPEP § 821.04(a). Applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the

present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

2. Restriction for examination purposes as indicated is proper because all these inventions listed in this action are independent or distinct for the reasons given above and there would be a serious search and examination burden if restriction were not required because one or more of the following reasons apply:

- (a) the inventions have acquired a separate status in the art in view of their different classification;
- (b) the inventions have acquired a separate status in the art due to their recognized divergent subject matter;
- (c) the inventions require a different field of search (for example, searching different classes/subclasses or electronic resources, or employing different search queries);
- (d) the prior art applicable to one invention would not likely be applicable to another invention;
- (e) the inventions are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected invention.

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Should applicant traverse on the ground that the inventions are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

3. Since the restriction is complex and the examiner knows from past experience that an election will not be made by telephone, this restriction is proper under MPEP 812.01.

Conclusion

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khanh H. Le whose telephone number is 571-272-6721. The Examiner works a part-time schedule and can normally be reached on Tuesday, Wednesday, and Friday 9:00-6:00.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, James W. Myhre can be reached on 571-272-6722. The fax phone numbers for the organization where this application or proceeding is assigned are **571-273-8300** for regular communications and for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-3600. For patent related correspondence, hand carry deliveries must be made to the Customer Service Window (now located at the Randolph Building, 401 Dulany Street, Alexandria, VA 22314)..

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

September 30, 2008

/Khanh H. Le/

Examiner, Art Unit 3688